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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/609,450	06/27/2003	James D. Balan	BALJ09A	6601

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EXAMINER

HAYES, BRET C

ART UNIT PAPER NUMBER

3644

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/609,450

Applicant(s)

BALAN, JAMES D.

Examiner

Bret C Hayes

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 6 is/are rejected.
- 7) ☒ Claim(s) 4 and 7-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The rejections under 112, 2nd paragraph, of the previous office action are hereby withdrawn due to the amendment to the claims.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 – 3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson (4,328,767).
4. Re – claim 1, Peterson discloses the invention substantially as claimed except for a pair of retractors 15. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use more than the one retractor disclosed by Peterson, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.
5. Re – claim 2, Peterson discloses a slender, elongated collar 10.
6. Re – claim 3, Peterson discloses a pair of ends, a ring 13 and the method of attaching.
7. Re – claim 5, Peterson disclose a slender, elongated leash 16.
8. Re – claim 6, Peterson discloses the leash having a pair of ends, but does not disclose each end being operatively connected to the pair of retractors. As applied to claim 1, the duplication of parts would have been obvious to one having ordinary skill in the art at the time

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the invention was made. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to so arrange the duplicated parts, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

Allowable Subject Matter

9. Claims 4 and 7 – 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record neither discloses nor fairly teaches the recited limitations of the claimed invention including, but not limited to: the combination including (claim 4) hook and loop fasteners allowing a second end of the collar to be adjustably and replaceably affixed to itself; (claim 7) and the retractors being on the collar and diametrically opposed to each other.

11. This statement is not intended to necessarily state all the reasons for allowance or all the details why the claims are allowed and has not been written to specifically or impliedly state that all the reasons for allowance are set forth (MPEP 1302.14).

Response to Arguments

12. Applicant's arguments filed 21 June 2004 have been fully considered but they are not persuasive.

13. In response to Applicant's argument that there is no motivating suggestion to modify the prior art reference, examiner has not combined any references, but rather merely put forth the rejection of the claimed invention as recited in the claims. In this case, Claim 1 recites, "A

retractable tether for a pet, comprising: a) a collar; b) a leash; and c) a pair of retractors; wherein said leash is retractably connected to said collar by said pair of retractors.” Peterson discloses a retractable tether for a pet, comprising: a) a collar **10**; b) a leash **16**; and c) a retractor **15**; wherein the leash **16** is retractably connected to the collar **10** by the retractor **15**. The only portions of the claimed invention lacking in Peterson are a pair of retractors and the leash being connected to the collar by the pair of retractors. Examiner provided no motivating suggestion to modify because *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, has held that mere duplication of essential working parts of a device involves only routine skill in the art and examiner need not provide any motivation where the Court has held such as obvious to one of ordinary skill in the art at the time the invention was made.

14. In response to the argument that, “Even though the advantages discussed throughout the instant amendment may not have been disclosed and discussed specifically in the specification of the patent application as it was originally filed, they still must be relied upon as evidence of patentability, as was decided in *In re Chu*, 66 F.3d 292, 36 USPQ 2d 1089 (Fed. Cir. 1995),” (*emphasis added*), examiner disagrees. The law would more appropriately be applied as, ‘even though the advantages discussed throughout the instant amendment may not have been disclosed and discussed specifically in the specification of the patent application as it was originally filed, they still must be relied upon as arguments of patentability’, and not evidence, as alleged, since the two are distinct and divergent legal concepts.

15. In response to the argument that “The configuration of the advantageous distinctive feature of claim 1 discussed supra is not merely a so-called duplication of the essential working parts of a device, but is significant and of critical importance.” Examiner disagrees. As noted

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above, the significance and critical importance of the configuration notwithstanding, the claimed invention does not distinguish from a leash being attached by a multitude of retractors, which has been held as being obvious as a mere duplication of essential working parts.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

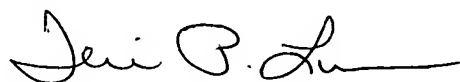
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu, can be reached at (703) 305 – 7421. The fax number is (703) 872 – 9306.

bh

9/7/04



TERI P. LUU
SUPERVISORY PRIMARY EXAMINER.